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TO: **Examiner M. Brannock - Art Unit 1646**
United States Patent & Trademark Office

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FROM: Mark J. Hyman (Reg. No. 46,789)

RE: Application No. 09/227,854 Atty. Docket No. PF210D1
Application of: Ni et al. Filed: January 11, 1999

The following documents were filed by Human Genome Sciences, Inc. via facsimile on May 11, 2004:

1. Fax Cover Sheet
2. Statement Pursuant to 37 C.F.R. § 1.608(a)
3. Certificate of Transmission Under 37 C.F.R. § 1.8

If you experience any difficulty receiving this transmission, please contact Mark J. Hyman at (240) 314-1224.

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REPLY UNDER 37 C.F.R. § 1.116 – EXPEDITED PROCEDURE
EXAMINING GROUP 1646

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ni et al.

Docket No.: PF210D1

Application No.: 09/227,854

Confirmation No.: 7606

Filed: January 11, 1999

Art Unit: 1646

For: Human Chemotactic Cytokine 1 Polypeptides

Examiner: M. Brannock

STATEMENT PURSUANT TO 37 C.F.R. § 1.608(a)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the undersigned's telephone conversation with the Examiner today, Applicants understand that an interference may be declared between the instant application and U.S. Patent No. 6,313,267 (Hitomi et al.). In order to satisfy 37 C.F.R. § 1.608(a), the Examiner has asked Applicants to submit a statement alleging that there is a basis upon which Applicants are entitled to a judgment relative to Hitomi et al.

As discussed with the Examiner, a Rule 608(a) showing should be sufficient to initiate an interference determination, as the effective filing date of the instant application (December 8, 1995) is less than three months after the effective U.S. filing date of the '267 patent (presumably December 6, 1995). The foreign priority claim of Hitomi et al. cannot be taken into account with respect to an interference determination. *See* M.P.E.P. § 2308.01; M.P.E.P. § 2136.03 (citing *In re Hilmer*):

> When an applicant attempts to provoke an interference with a patent, the examiner must determine the effective filing dates of the application and of the patent; only the patent's effective United States filing date will be considered. Any claim of foreign priority by the patentee under 35 U.S.C. 119(a) will not be taken into account when determining whether or not an interference should be declared.
> M.P.E.P. § 2308.01 at 2300-20 (emphasis added).

Applicants also note that a Rule 131 declaration was submitted on February 20, 2003, indicating Applicants' possession of the claimed invention in the United States prior to March 6, 1995. Such a declaration is sufficient to antedate the '267 patent's 102(e) date of December 6, 1995 and preclude a 35 U.S.C. § 102(e) rejection, unless the '267 patent "claims the same patentable invention as defined in § 1.601(n)" as the instant application. *See* 37 C.F.R. § 1.131(a)(1). Thus, by requesting a Rule 608(a) statement, the Examiner has implicitly asserted that the '267 patent claims the same patentable invention as the instant application. *See, e.g.*, M.P.E.P. § 715.05. Applicants point out, though, that the claims of the '267 patent require the protein to be "calcium-binding," a limitation not present in the claims of the instant application.

However, assuming *arguendo* that the instant application and the '267 patent claim the same patentable invention notwithstanding the differences in the claims, the undersigned attorney of record hereby states the following pursuant to 37 C.F.R. § 1.608(a):

> In light of the declaration submitted February 20, 2003 in the instant application, should an interference be declared between the instant application and U.S. Patent No. 6,313,267, there is a basis upon which Applicants are entitled to a judgment relative to the patentees.

The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicants would expedite the prosecution of this application.

Dated: May 11, 2004

Respectfully submitted,

By _____
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